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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,163	12/31/2003	James A. Harding	249768068US	5011
25996 7590 02/11/2008 PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER				
SHAH, AMEE A				
ART UNIT		PAPER NUMBER		
3625				
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02/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/750,163

Applicant(s)

HARDING ET AL.

Examiner

AMEE A. SHAH

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 3-11 are pending in this action.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 8-11, the preamble is directed to “a data transmission network” whereas the limitations appear to be directed to data only. It is not clear to one of ordinary skill in the art what constitutes the structure of the network as the claims recite no structural limitations.

Claim Rejections - 35 U.S.C. § 101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-11 are rejected under 35 U.S.C. §101 because the claimed inventions are directed to non-statutory subject matter. The limitations [body of the claim 8] are directed to disembodied data structure which are per se not statutory. C.f. In re Wamerdam. The limitations are directed to data, such as content for displaying, etc. which all represent a data structure resembling a data file without reciting any functional changes due to an application program and resulting in an useful, concrete and tangible result. Functional descriptive material, in

combination with a computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system is statutory i.e., a set of instructions in combination with a computer system. C.f. In re Wamerdam - data structure stored in a computer memory, and In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium.

A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101. Examples of Statutory Functional Descriptive Material are:

(a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See Wamerdam.

(b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al. See MPEP §2106.01.

Since claims 9-11 are dependencies of claim 8, they also inherit the same deficiency.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al., US 2001/0054008 A1 (hereafter referred to as “Miller”) in view of English, US 2003/0055723 A1 (hereafter referred to as “English”).

Referring to claims 3, 6 and 7. Miller teaches a method in a computing system for responding to a request for information about an item (see, e .g., Abstract), comprising:

- receiving a request for information about the item (Figs. 10 and 11 and ¶¶0171 and 0176);
- among a plurality of sellers, identifying those that are offering the item for sale and whose availability level for the selected item exceeds a predetermined availability threshold (¶¶0171, 0172, 0174, 0176 and 0178 – note the predetermined availability threshold is one, i.e. the item being in stock);
- selecting as the featured seller of the item the identified seller that is offering the selected item at the lowest price (¶¶0172 and 0178 – note the selection of the vendor can be based on price); and
- replying to the request for information with a web page containing both (1) information describing the item, and (2) a control that can be activated to order the item from the featured seller (Fig. 5A, which shows a hyperlink to "Buy It Now," and ¶¶0151, 0171, 0173, 0176 and 0179).

While Miller teaches identifying sellers based on various criteria, it does not explicitly teach. English teaches a method of comparing, advertising and switching vendors whereby vendors having the item for sale are selected based on a score relating to a plurality of different items offered for sale by the seller that exceeds a predetermined score threshold (¶0062 – note the score is the aggregate rating and the predetermined threshold is the current vendor aggregate rating). It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to apply the criteria including a seller score relating to a plurality of

different items offered for sale by the seller that exceeds a predetermined score threshold as taught by English to improve the step of identifying sellers in the commerce method of Miller for the predictable result of allowing customers to have more and better access to information relating to an item in order for the customer to make better purchasing decisions, as suggested by Miller (§0007).

Referring to claim 4. Miller in view of English teaches the method of claim 3 wherein the identifying and selecting is performed before the receiving (Miller, §0175 and English, §0074 – note that by having featured vendors being selected from those that have paid a fee, the identifying and selecting occurs before a request is received).

Referring to claim 5. Miller in view of English teaches the method of claim 3 wherein the identifying and selecting is performed periodically (Miller, §0179 – note the period is each time a request is received), and the most recently selected featured seller is used in replying to each of a plurality of received requests (Miller, §§0175 and 0188 – note the most recently selected featured seller is determined by the paying seller and the most hits).

Referring to claims 8-11. All of the functional limitations in apparatus claims 8-11 are closely parallel to the limitations of method claims 3-6, analyzed above and are rejected on the same bases.

Response to Amendment

Applicant's amendment, filed October 3, 2007, has been entered. Claims 1, 2 and 12-32 have been cancelled. Claims 5 and 8-11 have been amended. In view of the replacement drawings, the objections to the drawings are withdrawn. In view of the amended Abstract, the objections to the specification are withdrawn. In view of the amendments to claim 5, the 35 U.S.C. §112 rejections are withdrawn. However, with respect to amended claims 8-11, new 35 U.S.C. §§112 and 101 rejections are made, as discussed above.

Response to Arguments

Applicant's arguments filed October 3, 2007, have been fully considered but they are not persuasive. In response to applicant's argument that Miller does not teach "a control that can be activated to order the selected item from a feature seller" (Remarks, page 8), the Examiner disagrees. Miller, in figure 5A, shows a hyperlink that says "Buy It Now." This hyperlink, when pressed, directs the user to the vendor for the stated purpose of buying the item, and thus is a control that can be activated to order the item.

In response to applicant's argument that there is no motivation to combine English with Miller (Remarks, page 9), the Examiner directs applicant's attention to KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), which forecloses applicant's argument that a specific teaching is required for a finding of obviousness, id., 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS
February 1, 2008

/Yogesh C Garg/
Primary Examiner, Art Unit 3625